REMARKS

Claims 6, 8-14, 20, 32, 36-48, 58, 63, 68, and 71-73 are cancelled; thus, claims 1-5, 7, 15-19, 21-31, 33-35, 49-57, 59-62, 64-67, and 69-70 are all the claims pending in the application. Claims 1-5, 7-12, 14-19, 21-31, 33-44, 46-57, 59-62, and 64-66, stand rejected on prior art grounds. Claims 14, 21, and 72-73 stand rejected upon informalities. Applicants respectfully traverse these rejections based on the following discussion.

I.   The 35 U.S.C. §112, Second Paragraph, Rejection

Claims 14, 21, and 72-73 stand rejected under 35 U.S.C. §112, second paragraph. These rejections are traversed as explained below. More specifically, the Office Action asserts that "[c]laim 14 is an apparatus claim, yet appears to describe how the apparatus is used rather than structural features of the apparatus" (Office Action, p. 2, item 3). Applicants have amended claim 14 to define that "said networked environment is operatively connected to one or more of the group consisting of ..." As such, Applicants submit that claim 14, as amended, describes the "structural features of the apparatus".

In addition, the Office Action asserts that "[c]laim 21 is an apparatus/program on a medium claim, yet appears to describe how the apparatus is used rather than programmed features of the apparatus/medium" (Office Action, p. 3, item 3). Applicants have amended claim 21 to define that "said networked environment is implemented utilizing is operatively connected to one or more of the group consisting of ..." As such, Applicants submit that claim 21, as amended, describes "programmed features of the apparatus/medium".

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

II.   The Prior Art Rejections

Claims 1-5, 7-12, 14-19, 21-31, 33, 35-44, 46-, 48-57, 59, 61-62, and 65-66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski (U.S. Patent No. 6,932,270). Claims 3, 10, 17, 34, 47, 60, and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, in view of Beach, et al. (U.S. Publication No. 2002/0107738), hereinafter referred to as Beach. Claims 1-5, 7-12, 14-19, 21-31, 33, 35-44, 46, 48-57, 59, 61-62, and 65-66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, in view of Marmon (U.S. Patent No. 4,446,528). Claims 3, 10, 17, 34, 47, 60, and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, in view of Beach. Applicants respectfully traverse these rejections based on the following discussion.

The claimed invention provides a method of determining a combination of electronic coupons (e-coupons) for redemption by a retailer in a networked environment. The method determines if a selection of e-coupons complies with redeeming conditions and determines if two or more of the e-coupons can be used in combination within the same purchase. Moreover, the method checks the selection of e-coupons complying with the redeeming conditions and capable of being used in combination within the same purchase to determine if the selection of coupons satisfy *optimization parameters*. The method only displays the selection of e-coupons complying with the redeeming

conditions and capable of being used in combination within the same purchase that *satisfy the optimization parameters*.

In the rejection, the Office Action argues that the prior art of record discloses many features of the claimed invention. However, the Office Action fails to provide any support within the prior art references that mentions determining whether a selection of coupons satisfy "optimization parameters" and only displaying such coupons. Instead, the Office Action merely asserts that such features would "be a matter of good customer service" and because "customers [are] faced with navigating the coupon rules and options imposed by the retailer". Additionally, nothing the Office Action does not provide any support within the prior art that mentions that "said optimization parameters comprise at least one of a discount amount, loyalty points, a number of free items received, earmarked coupons, non-earmarked coupons, expiration date, and a total number of coupons used". Therefore, as explained in greater detail below, Applicants respectfully submit that the prior art of record does not teach or suggest the claimed invention.

Applicants traverse the rejections because the prior art of record does not teach or suggest determining if a selection of coupons satisfy *optimization parameters* and only displaying the selection of coupons that *satisfy the optimization parameters*. Such features are defined in independent claims 1, 15, 22, 49, and 62 using similar language.

The Office Action argues that "[o]ne of ordinary skill would consider it to be a matter of good customer service for a checkout clerk to assist a customer regarding … which subset of coupons would most benefit the customer for example helping a customer who asks 'which coupon(s) would save the most money?'" (Office Action, p. 5,

para. 1). Moreover, the Office Action argues that "it would have been obvious to one of ordinary skill at the time of the invention to have also provided automated coupon optimization assistance (i.e., indicating the best coupon(s) to use in order to best reduce the price given the subset of eligible coupons possessed) to customers faced with navigating the coupon rules and options imposed by the retailer" (Office Action, p. 10, para. 1).

Nevertheless, the Office Action fails to provide any support within the prior art references that mentions determining whether a selection of coupons satisfy "optimization parameters" and only displaying such coupons. Instead, the Office Action merely asserts that such features would "be a matter of good customer service" and because "customers [are] faced with navigating the coupon rules and options imposed by the retailer" (Office Action, p. 5, para. 1; p. 10, para. 1).

Accordingly, it is Applicants' position that the prior art of record fails to teach or suggest the claimed features of "checking … to determine if said selection of coupons satisfy said optimization parameters; and displaying only said selection of e-coupons … that satisfy said optimization parameters" as defined in independent claims 1 and 15. Further, the prior art of record fails to teach or suggest the claimed features of "determining if said computed set of e-coupons … satisfy optimization parameters … and displaying only said computed set of e-coupons … that satisfy said optimization parameters" as defined in independent claims 22 and 49. Additionally, the prior art of record fails to teach or suggest the claimed features of "an optimization engine adapted to

determine a subset of coupons ... dependent upon optimization parameters" as defined in independent claim 62.

In addition, Applicants traverse the rejections because the prior art of record fails to teach or suggest the claimed features, "wherein said optimization parameters comprise at least one of a discount amount, loyalty points, a number of free items received, earmarked coupons, non-earmarked coupons, expiration date, and a total number of coupons used". Such features are defined in independent claims 22, 49 and dependent claims 67, 69, 70 using identical language.

Applicants submit that the Office Action does not address these claimed features. Further, Applicants submit that the Office Action does not assert that claims 67 and 69-70 are rejected.

Therefore, it is Applicants' position that the prior art of record does not teach or suggest many features defined by independent claims 1, 15, 22, 49, and 62 and that such claims are patentable over the prior art of record. Further, it is Applicants' position that dependent claims 2-5, 7, 16-19, 21, 23-31, 33-35, 50-57, 59-61, 64-67, and 69-70 are similarly patentable, not only because of their dependency from a patentable independent claims, but also because of the additional features of the invention they defined. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

II.   Formal Matters and Conclusion

In view of the foregoing, Applicants submit that claims 1-5, 7, 15-19, 21-31, 33-35, 49-57, 59-62, 64-67, and 69-70, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

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